

REMARKS

By this Amendment, Applicant has submitted three (3) replacement drawing sheets containing Figs. 2-4; canceled claim 12 without prejudice or disclaimer; amended claims 1, 60, and 69;¹ and added new claims 90-95. No new matter has been added.

The Office Action includes a Notice of Draftsperson's Patent Drawing Review, which apparently indicates that Figs. 2-4 contain "[l]ines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality)." Applicant has submitted three (3) formal replacement drawing sheets that contain Figs. 2-4, which have improved line quality so as to be in full compliance with 37 C.F.R. § 1.84(i). Therefore, Applicant respectfully requests reconsideration and withdrawal of the objection to drawing Figs. 2-4.

In the Office Action, claims 1-6, 8, 10, 13-15, 18-24, 26, 34-39, 48, 49, 60-65, 67, 70-72, 75-79, 81, and 89 were rejected under either 35 U.S.C. § 102(b) or § 103(a) based on Street (U.S. Patent No. 6,017,351). The only independent claims rejected under § 102(b) based on the Street reference are claims 1 and 60. Applicant has amended claims 1 and 60 to recite an envelope "configured as one of a glove and a mitten." Claims 1 and 60 read on the previously elected species of Fig. 4, and they are also generic to the species corresponding to Figs. 1, 2, and 4. As explained below, those independent claims are allowable over Street.

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¹ Amended claim 69 reads on the elected species of Fig. 4.

Independent Claim 1

Independent claim 1 recites a device for treating a keratinous surface of a body, including, among other elements, an envelope “configured as one of a glove and a mitten.”

The Street reference neither discloses nor suggests at least that subject matter recited in claim 1. The Street reference discloses a method and cosmetic abrasive scrubbing pad for scrubbing and removing detritus (such as dead skin or dander), soil, and other foreign matter from the epidermis. The cosmetic abrasive scrubbing pad includes a lofty, non-woven, open abrasive pad formed in a substantially rectangular or circular shape and sized to be either held in the user’s hand or formed as a mitt in the form of a sleeve lacking any individual finger and/or thumb portion. The cosmetic abrasive pad includes a segment of lofty, fibrous, non-woven structure of mixed denier nylon or polyester crimped or bent filaments bonded at contacting points with a binder such as thermosetting binder resin or the like and containing finely divided, biocompatible, soft abrasive particles. The embodiment of cosmetic abrasive scrubbing pad depicted in Figs. 12 and 13 includes an abrasive pad mitt 100 defined by a sleeve having first and second permanently stitched or attached abrasive segments 110 and 112, and an opening 118 sized to receive a user’s hand. The mitt 100 includes a first segment 110 having a mildly abrasive nature and a second segment 112 having a more aggressively abrasive nature. The mildly abrasive first segment 110 may be capable of cleaning the softest skin, such as skin on the face and around the eyes, and the more aggressively abrasive second segment 112 may be capable of softening and scouring away tougher, thickened dead calloused skin, such as skin found on the heels, palms, and the like. The Street reference, however, does not disclose or suggest an

envelope, "wherein the envelope is configured as one of a glove and a mitten," as recited in claim 1.

The Office Action acknowledges that the Street reference fails to disclose a glove. Office Action at 3. The Office Action's rejection statement, however, concludes "it would have been obvious to one of ordinary skill in the art . . . to have made the hand-held Street device in the shape of a glove since it has been held that mere changes in shape are a matter of obvious design choice absent any persuasive evidence that the particular shape or configuration is significant." Id. (citing In re Dailey, 357 F.2d 699, 149 U.S.P.Q. (BNA) 47 (C.C.P.A. 1966)²). Applicant respectfully traverses that unsupported conclusion because the Office Action fails to establish a *prima facie* case of obviousness since there is no suggestion or motivation in the Street reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the device of Street in the hypothetical manner proposed by the rejection statement.

To establish a case of *prima facie* obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143. In addition, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings." Id.

Rather than relying on the Street reference or knowledge generally available to one of ordinary skill in the art to supply any suggestion or motivation to modify the

² The rejection statement appears to be referring to a 1966 decision by the Court of Customs and Patent Appeals (CCPA), In re Dailey, even though the rejection statement's citation to In re Dailey indicates that it was rendered in 1976. See Office Action at 3 (citing "In re Dailey, 149 USPQ 47(CCPA 1976)"). Applicant is unaware of any CCPA decision styled In re Dailey rendered in 1976.

device of Street in the hypothetical manner proposed in the rejection statement, the rejection statement instead relies on a vague statement about "mere changes in shape" taken out of context from an outdated Court of Customs and Patent Appeals decision.

In contrast to that vague statement from an outdated case, a very recent Federal Circuit decision cautions that

[an] examiner's conclusory statements . . . do not adequately address the issue of motivation This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to [modify a reference] simply to "[use] that which the inventor taught against its teacher."

In re Lee, 277 F.3d 1338, 1343-44, 2002 U.S. App. LEXIS 855, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002) (citation omitted).

In the absence of any suggestion or motivation in the Street reference itself, and in absence of any sufficient explanation from the Office Action supporting the rejection statement's conclusion, it appears the Office Action has relied instead on hindsight and the teaching of Applicant's own disclosure in order to modify Street.

By citing In re Dailey, the rejection statement appears to be relying solely on legal precedent in an attempt to provide a rationale for supporting the rejection. Applicant points out, however, that "legal precedent can provide the rationale supporting obviousness only if the facts in the case [cited] are sufficiently similar to those in the application." M.P.E.P. § 2144. The facts of In re Dailey are not sufficiently similar to those in the present application to support the rejection statement's hypothetical modification to the Street device.

In In re Dailey, Dailey disclosed and claimed a collapsible nursing container (i.e., a baby bottle) having top and bottom external sections having a generally spherical

shape being "somewhat less than hemispherical in extent." In re Dailey, 357 F.2d 699, 670, 149 U.S.P.Q. (BNA) 47 (C.C.P.A. 1966). The prior art cited by the Examiner in a rejection under § 103, Matzen, was different in pertinent part only to the extent that its top and bottom external sections were generally fully hemispherical instead of "somewhat less than hemispherical." Id. In other words, Dailey's device was distinguishable only by a very insignificant and slight change from a fully hemispherical shape. In addition, the CCPA noted that Dailey had provided "no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen." Id. at 672-73.

As is readily apparent, the facts in the present application are not similar to those of In re Dailey. For example, no arguments were made by Dailey that the distinguishable difference between his container and the container of Matzen were anything other than aesthetic differences. In contrast, the differences between the subject matter recited in Applicant's claim 1 and the Street reference are not merely aesthetic. For example, Applicant's exemplary embodiments in which the envelope is configured as a glove or a mitten, as recited in claim 1, are more than merely aesthetically different from the subject matter of Street. The envelope configured as a glove or a mitten may, for example, substantially prevent or hinder the envelope from rotating on the user's hand when a user uses it for treating his/her body. Such exemplary embodiments may also (or alternatively) enable a user to involve his/her finger(s) and/or thumb in a body treatment. Accordingly, the facts of In re Dailey are inapposite to the facts of the present application. Therefore, it is improper to rely solely

on the legal precedent established by In re Dailey in order to modify Street in the § 103 rejection of the claims.

Therefore, Applicant respectfully submits that the claim rejection under § 103(a) based on the Street reference is improper and should be withdrawn since the Office Action has failed to set forth a *prima facie* case of obviousness with respect to at least that rejection.

Independent Claim 60

Like claim 1, independent claim 60 recites a device for treating a keratinous surface of a body including an envelope “configured as one of a glove and a mitten.” For at least the same reasons claim 1 is allowable, claim 60 should be allowable.

New Independent Claims 90 and 93

New independent claims 90 and 93 (and new dependent claims 91, 92, 93, 94, and 95) read on the elected species of Fig. 4 and are generic to the species of Figs. 1, 2, and 4. Each of those new independent claims recites a device for treating a keratinous surface of a body including an envelope “configured to have two independent thumb portions located at opposite lateral ends of the envelope.” The Street reference fails to disclose or suggest at least that subject matter recited in new independent claims 90 and 93.

In the Office Action, claims 16, 17, 25, 27-33, 40-47, 50-59, 73, 74, 80, 82, and 83-88 were rejected under 35 U.S.C. § 103(a) based on Street in view of one or more of the following references: Snyder et al. (U.S. Patent No. 4,319,956); Ginger et al. (U.S. Patent No. 4,347,931); and Gruenbacher et al. (U.S. Patent No. 6,508,602). Since each

of those claims depends from one of the above-mentioned independent claims, those dependent claims should be allowable for at least the same reasons as their corresponding independent claims.

Conclusion

For at least the reasons set forth above, independent claims 1, 60, 90, and 93 should be allowable. Dependent claims 2-6, 8, 10, 13-59, 61-65, 70-89, 91, 92, 94, and 95 depend from one of independent claims 1, 60, 90, and 93. Consequently, those dependent claims should be allowable for at least the same reasons the claims from which they depend are allowable.

Therefore, Applicant respectfully requests the reconsideration of this application, the withdrawal of the outstanding drawing objection and claim rejections, and the allowance of claims 1-6, 8, 10, 13-65, and 70-95. In addition, since generic claims 1 and 60 are allowable, claims 7, 9, 11, 66, and 68 should be examined.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned representative at (571) 203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant declines to automatically subscribe to them.

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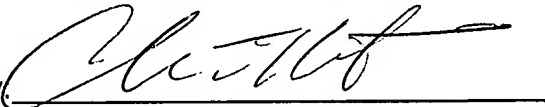
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By



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Attachments: three formal replacement drawing sheets

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